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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,169	10/17/2001	Hitoshi Suzuki	MRI-014	3948
20374	7590	05/19/2004	EXAMINER	
KUBOVCIK & KUBOVCIK SUITE 710 900 17TH STREET NW WASHINGTON, DC 20006			THOMPSON, KATHRYN L	
			ART UNIT	PAPER NUMBER
			3763	9
DATE MAILED: 05/19/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/978,169	SUZUKI ET AL.
	Examiner	Art Unit
	Kathryn L Thompson	3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 03 March 2004.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 2-8,10,12 and 14-19 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,9,11 and 13 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 17 October 2001 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Election/Restrictions***

Claims 2-8, 10, 12, and 14-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group and species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 8. Applicant states that Claims 18 and 19 should be included with the Group 1 invention since they are directed to a syringe. Examiner agrees with Applicant. Therefore, the modified version of the prior restriction requirement is the following: Group I: Claims 1-16, 18, and 19; Group II: Claim 17. Examiner further withdraws Claims 3, 4, 5, 7, 8, 10, 12, and 14 as being drawn to a non-elected species. Specifically, Claim 3 is directed to Figure 5, a non-elected Species and Claims 4, 5, 7, 8, 10, 12, and 14 are directed to the embodiments in which the direction in which the plate member is bent is convex toward the needle. As disclosed in the specification, the elected species of Figure 14 discloses that the plate member is widthwise concaved toward the needle.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 9, 11, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Morrison (US 5,584,818). Morrison discloses a needle-point covering member comprising a plate member (17) which can be bent, a covering portion (1) for covering the needlepoint when the bent plate member is extended, a bending-position-maintaining member for maintaining the plate member in the bent state, and a trigger-function portion (Figure 18).

Claims 1, 9, 11, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Sweeney et al (US 5,348,544). Sweeney et al discloses a needle-point covering member (12) comprising a plate member (54) which can be bent, a covering portion (42) for covering the needlepoint when the bent plate member is extended, a bending-position-maintaining member for maintaining the plate member in the bent state, and a trigger-function portion (Figure 3).

Claims 1, 9, 11, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Elson et al (US 5,814,018). Elson et al discloses a needle-point covering member (100) comprising a plate member (130) which can be bent, a covering portion (110) for covering the needlepoint when the bent plate member is extended, a bending-position-maintaining member for maintaining the plate member in the bent state, and a trigger-function portion (All figures).

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nestell (US 5,925,020) and Noiles (US 3,840,008) both disclose a needle-point covering member.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn L Thompson whose telephone number is 703-305-3286. The examiner can normally be reached on 8:30 AM - 6:00 PM: 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 703-308-3552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KLT

*Kat*

*Brian L. Casler*  
BRIAN L. CASLER  
SUPERVISORY PATENT EXAMINER  
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